

## **REMARKS/ARGUMENTS**

The currently pending claims of the application were rejected in the May 15, 2006 Office Action under various references, as more fully explained below. In response, applicant has amended claims 1, 7 and 19; canceled claims 4-6, 20, 21, and 24-54; and added new claims 55-67. Based on the foregoing amendments and the following remarks, applicant respectfully requests reconsideration and reexamination of the application, as amended.

### **Time Extension Request**

Submitted herewith is a request for a 3-month time extension, with appropriate fee.

### **Objection to Specification**

Applicant has corrected the Related Application section of the Specification, as required by the Examiner.

### **Double Patenting**

Applicant submits herewith a Terminal Disclaimer in order to overcome the non-statutory obviousness-type double patenting rejection of claims 1-9 and 17-23.

### **Claim Rejections - 35 U.S.C. §112**

Applicant has amended claims 1 and 19 (applicant believes claim 17 was erroneously indicated in the Office Action) to replace "the area" with "an area", as well as to insert the term "of dysfunction" immediately after "area". Applicant believes that these amendments overcome the §112 rejections.

### **Claim Rejections - 35 U.S.C. §102**

Claims 1-4, 9, 17-19, 22 and 23 were rejected under 35 U.S.C. §102(b) as being anticipated by Allum (U.S. Patent No. 6,063,046). Allum discloses a method and apparatus for the diagnosis and rehabilitation of balance disorders. Briefly, a subject is placed in a standing position on a support surface (wobble board or the like) which can be moved in any combination of pitch and roll directions. Measurements of the balance response of the subject are made using sensors and the like placed on the subject's body. From the response measures, an operator of the system may diagnose the existence or cause of a balance correction abnormality. The system provides response

measure information in the form of feedback to the test subject, such as visual, auditory, tactile, etc. That is, if the subject is diagnosed as having a balance abnormality, visual screens, auditory signals, or electrical stimuli are used to alert the subject that the subject is not properly correcting for the imbalance, and thus the subject corrects his or her balance by either distributing weight to the left or to the right in response to such feedback.

The present invention resides in a process for identifying and treating neurological disorders. The present invention tests for and identifies a neurological dysfunction by performing a combined test. Neurological dysfunction is restored by resetting nerve supply to an area of dysfunction or physical function being tested by performing corrections for dysfunction until no dysfunction is detected (see independent claims 1, 19 and 55).

As recited in independent claim 1, the resetting step includes a step of stimulating the area of dysfunction, spine and head through the use of a therapeutic device. As recited in independent claims 19 and 55, the correction comprises physically manipulating tissue or bone that entraps a vein, artery or nerve associated with the dysfunction.

Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly "teaches". *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). For a prior art reference to anticipate in terms of 35 USC § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). That is, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991).

Applicant respectfully submits that every element of the claimed invention, as recited in independent claims 1, 19 and 55, is not shown or disclosed in the Allum reference. Moreover, applicant respectfully submits that one of ordinary skill in the field of the invention would view significant differences between the claimed invention and the Allum disclosure.

Applicant has combined the recitations of dependent claims 5 and 6 with claim 1. However, these claims were rejected over the combination of Allum in view of Walker, and this will be discussed more fully below.

Independent claim 19 has been amended to recite that the correction comprises physically manipulating tissue or bone that entraps a vein, artery or nerve associated with the dysfunction (that is applicant has canceled the recitation of “or stimulating the area of dysfunction, spine and head through the use of a therapeutic device”). Applicant respectfully submits that there is no teaching whatsoever in Allum to physically manipulate tissue or bone that entraps a vein, artery or nerve associated with the dysfunction. Moreover, there is no teaching or disclosure in Allum to reset nerve supply to an area of dysfunction by performing corrections for dysfunction until no dysfunction is detected. Accordingly, applicant submits that there is not a one-to-one relationship between the recitations of independent claims 19 and 55 and the Allum reference. Accordingly, applicant respectfully submits that Allum does not anticipate these independent claims, nor those claims depending therefrom, and the rejection should be withdrawn.

#### Claim Rejections - 35 U.S.C. §103

Claims 1, 5-7, 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allum in view of Walker (U.S. Patent No. 4, 671,285). In the Office Action, it is admitted that Allum does not restore neurological function by resetting nerve supply through stimulation with a light-generating device. Walker discloses treatment of human neurological problems by laser photo stimulation. As stated in the Abstract of Walker, Walker treats nerve damage in humans by applying an essentially monochromatic light to the skin area adjacent to the damaged nerve region of the body.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior

art, and not based on Applicant's disclosure. M.P.E.P. §2143 (citing *In re Vaeck*, 20 USPQ 2d 1438 (Fed.Cir. 1991).

Applicant respectfully submits that there is no suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to combine and modify the Allum and Walker references as proposed by the Examiner. In fact, applicant submits that the teachings of Allum and Walker are only analogous to one another given the teachings of the present application, otherwise, the references are completely non-analogous. Of course, it is axiomatic that a claimed invention is not obvious solely because it is composed of elements that are individually found in the prior art. *Life Technologies, Inc. v. Clonetech Laboratories, Inc.*, 56 USPQ 2d 1186 (Fed. Cir. 2000).

Moreover, applicant respectfully submits that the teachings of Allum and Walker are directed to entirely different problems. That is, Allum is specifically directed to determining and correcting balance abnormalities. On the other hand, Walker is directed to the treatment of pain of damaged nerve regions of the body.

The Examiner picks and chooses aspects of the references in light of Applicant's claims in attempting to reconstruct Applicant's invention. The Examiner's assertions are not supported by the references, but are impermissible hindsight based upon the teachings of Applicant's invention

"When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself..."

*Uniroyal Inc. vs. Rudkin-Wiley Corp.* 5 USPQ 2d 1434, 1438 (Fed. Cir. 1988). It is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention, and the Examiner must avoid the "insidious effect of a hindsight syndrome wherein only that which the inventor taught is used against the teacher". *W.L. Gore & Assoc. v. Garlock*, 721 F.2d 1540, 1552, 1553, 220 USPQ 303, 312, 313 (Fed. Cir. 1988).

The burden is on the Examiner to particularly identify the suggestion, teaching, or motivation in the reference(s) for their combination, and not just naming similarities

between the reference(s) and the claimed invention. *Ruiz v. A.B. Chance Co.*, 234 F.3d 654 (Fed. Cir. 2000), 57 USPQ 2d 1161, 1166; *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), 50 USPQ 2d 1614, 1618.

"[A] rejection cannot be predicated on the mere identification ... of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."

*Ecolochem Inc. v. Southern California Edison*, 56 USPQ 2d 1065, 1076 (Fed. Cir. 2000) quoting *In re Rouffett*, 149 Fed. 3d 1350, 1357 (Fed. Cir. 1998), 47 USPQ 2d 1453, 1456.

Furthermore, the combination of Walker and Allum fail to disclose all of the recitations of the independent claims. For example, neither Allum nor Walker disclose stimulating the area of dysfunction, spine and head, as recited in independent claim 1. Nor do Allum nor Walker disclose physically manipulating tissue or bone that entraps a vein, artery or nerve associated with the dysfunction, as recited in independent claims 19 and 55. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)).

Accordingly, applicant respectfully submits that Allum and Walker are improperly combined, and even if combined with one another fail to teach all of the recitations of the independent claims, and thus this rejection fails and should be withdrawn.

Claims 8 and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Allum in view of Walker and further in view of Jobsis (U.S. Patent No. 4,281,645). The Office Action admits that neither Allum nor Walker disclose the use of a light-generating device being a light emitting diode. Jobsis discloses an apparatus for monitoring metabolism and body organs, such as introducing a metabolite into the body and subsequently using a laser or light emitting diode device to sense and monitor the

metabolite to determine the organ's function or dysfunction, such as failure to incorporate or break down the metabolite. Of course, this has absolutely nothing to do with the invention nor does it have anything to do with the teachings of Walker nor Allum. Instead, it has been added to Walker and Allum in an attempt to recreate the invention, as taught by applicant. Of course, such hindsight is strictly forbidden and impermissible.

Accordingly, claim 8 is not rendered unpatentable by this improper combination.

In light of the foregoing, applicant respectfully submits that independent claims 1, 19 and 55 are in condition for allowance. Although this application is the subject of a restriction requirement, and applicant originally elected claims 1-9 and 17-23, in the April 12, 2006 Restriction Requirement from the Examiner the Examiner indicated that claims 6 and 19 were generic (see page 3, paragraph 4). As independent claim 1 is a combination of claims 1, 5 and 6 it is generic to the remaining claims depending therefrom, and thus claims 10-16 are also in condition for allowance. New independent claim 55 mirrors independent claim 19, without restricting the claim to any particular combined motor test. That is, independent claim 55 is independent claim 19, with the "wherein two muscles are tested simultaneously" recitation removed. As independent claim 19 was indicated as being generic in the Restriction Requirement, independent claim 55 should also be construed as being generic as it is actually broader in scope than independent claim 19. Thus, those claims depending therefrom (56-67) should be allowed as well.

Respectfully submitted,

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